REMARKS

The Applicants have studied the Office Action dated January 2, 2004 and have made amendments to the claims to distinctly claim and particularly point out the subject matter which the Applicants regard as the invention. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-24 are pending. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

(1) objected to the title because it was not descriptive;

(2-17) rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over Discount et al. (U.S. 6,012,066) in view of Carlin (U.S. Pub. No. 2002/0093538); and

(18-19) rejected claims 24 under 35 U.S.C. § 103(a) as being unpatentable over Volk et al. (U.S. 5,673,401 in view of Discount et al. (U.S. 6,012,066) in view of Carlin (U.S. Pub. No. 2002/0093538).

Objection to the Title

As noted above, the Examiner objected to the title because it was not descriptive. The Applicants have amended the title as suggested by the Examiner. Accordingly, the Applicants respectfully submit that the Examiner's rejection to the title has been overcome and should be withdrawn.

Overview of the Present Invention

The present invention is directed to a method, system and computer readable medium for providing targeted advertising during execution of an application as described. The present invention includes an application for rendering three-dimensional graphical display objects (3D objects) used to represent real-life objects in computer applications such as games. The 3D objects include billboards, automobiles, and avatars and each

of the 3D objects have default textures associated with them. One or more of the default texture maps are replaced with advertising texture maps directed towards a demographic. The advertising texture map includes a logo representing the advertiser; text representing the advertiser; a person representing the advertiser; and an image representing the advertiser. A texture map is typically a two-dimensional picture or pattern that is mapped onto the surface of a 3D object. A texture map is represented by a bitmap or other picture file format such as JPEG, GIF or TIFF. In order to add to the realism or aesthetic of a 3D object, texture maps are often mapped onto the 3D object. This process is called "texture mapping," "mapping," or "applying." See the present invention summary, specification (pages 8-14) and FIGs. 2-4.

In order to more particularly point out this feature of replacing on-the-fly during program execution default texture maps of 3D objects, the following language has been added to the independent claims, i.e., claims 1, 7, 15, 23, and 24 as follows:

- claims 1 and 23

  assembling an application including a plurality of 3D objects, wherein each of the plurality of objects has a default texture associated therewith, the application with access to the plurality of advertising texture maps, wherein at least one of the plurality of advertising texture maps are mapped onto at least one of the plurality of 3D objects during execution of the application so as to replace at least part of the default texture associated therewith

- claims 7 and 23

  executing an application that presents a plurality of 3D objects, the application with access to a plurality of advertising texture maps wherein each of the plurality of objects has a default texture associated therewith;

  mapping at least one of the plurality of advertising texture maps onto at least one of the plurality of 3D objects during execution of the application so as to replace at least part of the default texture associated therewith;

- claim 15

  mapping at least one of the plurality of advertising texture maps onto at least one of the plurality of 3D objects during execution of the application, so as to replace at least part of a default texture associated with each of the plurality of

3D objects;

- claim 24

an application that presents a plurality of 3D objects, wherein each of the plurality of objects has a default texture associated therewith, the application includes a plurality of advertising texture maps, wherein at least one of the advertising texture maps are directed towards a demographic of the client system and wherein at least one of the plurality of advertising texture maps are mapped onto the plurality of 3D objects during execution of the application; and

a network connection to a third party, wherein advertising texture maps directed towards the demographic of the client system are periodically received from the third party via the connection and wherein the at least one of plurality of advertising texture maps are mapped onto at least one of the plurality of 3D objects during execution of the application.

Rejection under 35 U.S.C. §103(a) over Discount and Carlin

As noted above, the Examiner rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over Discount et al. (U.S. 6,012,066) in view of Carlin (U.S. Pub. No. 2002/0093538). The Applicants have amended independent claims 1, 7, 15, 23 and 24 to distinguish over Discount taken alone and/or in view of Carlin. Specifically, the present invention is directed to replacing default texture maps of realistic 3D objects with "advertising texture maps" by a process known in the video graphic technology of texture mapping. The "advertising texture maps" unlike generic advertising brochures or advertisement found on most web pages are images, texts, photos, that are "texture mapped" onto a 3D object so as to replace a texture map associated with the 3D object.

As the Examiner correctly states in the Office Action at page 3, Discount is silent on "advertising texture maps" and goes on to combine Carlin.[1] The concept of "advertising images" described by Carlin is not the same as with "advertising texture maps" as recited in the present invention. See Carlin at least at Sections 0003, 0005, 0061,

[1] Applicants make no statement whether such combination is even proper.

0064, and 0180-0184). Carlin's use of advertising images is directed to representations of objects for sale as part of the overall three-dimensional image. In contrast, the present invention is directed to bit multiplexing through texture mapping one or more "advertising texture maps" to replace texture maps of default objects in a scene. For example, in a video game, a billboard with a blank default texture is replaced with an advertising logo from a supplier of cola. (See for example FIG. 3 of the present invention). This act of replacing default textures of objects with "advertising texture maps" is no where suggested or taught by Carlin. Rather Carlin is directed to having a 3D object, where the default advertising image is integral to the object itself. The advertising images are inserted through interaction with professional interior designer decorators and sales associates. See Carlin section 0005. There is no suggestion or teaching in Carlin of replacing one texture with another "so as to replace at least part of the default texture associated therewith." This type of on-the-fly replacement during application execution is not taught by Carlin. Further in the present invention, in contrast to Carlin, the provider of the application (e.g. game) with direction from an advertiser determines which "advertising texture map" is used to replace a default texture map based on demographics. This is not the same as Carlin where the user of the computer, such as a sales associate, controls "advertising images."

The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." The Discount reference taken alone and/or in view of Carlin simply does not suggest, teach or disclose the patentably distinct limitations of "an application including a plurality of 3D objects, wherein each of the plurality of objects has a default texture associated therewith of to replace at least part of the default texture associated therewith" and mapping "advertising texture maps ... so as to replace at least part of the default texture associated therewith." Accordingly, the present invention distinguishes over Discount taken alone and/or in view of Carlin for at least this reason and the Examiner's rejection should be withdrawn.

Moreover, the Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here the intent, purpose and function of Carlin is to have an end-user select 3D objects with textures to create realistic images of advertising objects. In contrast, the intent of the present invention is for the provider of the application (e.g. game) with direction from an advertiser to determine which "advertising texture map" is used to replace a default texture map based on demographics. This combination, as suggested by the Examiner, destroys the intent and purpose of Discount taken alone and/or in view of Carlin's use of "advertising images" selected by sales personnel. Accordingly, the present invention is distinguishable over Discount taken alone and/or in view of Carlin for this reason as well.

Continuing further, when there is no suggestion or teaching in the prior art for "wherein each of the plurality of objects has a default texture associated therewith" and mapping "advertising texture maps ... so as to replace at least part of the default texture associated therewith", the suggestion can not come from the Applicants own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art references of Discount taken alone and/or in view of Carlin does not even suggest, teach nor mention replacing "at least part of the default texture associated therewith" of a 3-D object during program execution. Accordingly, the present invention is distinguishable over Discount taken alone and/or in view of Carlin for this reason as well.

Rejection under 35 U.S.C. §103(a) over Volk, Discount and Carlin

As noted above, the Examiner rejected claims 1-23 under 35 U.S.C. § 103(a) as being

unpatentable over Volk et al. (U.S. 5,673,401) in view of Discount et al. (U.S. 6,012,066) in view of Carlin (U.S. Pub. No. 2002/0093538). Independent claims 1, 7, 15, 23, and 24 have been amended to distinguish over Volk et al (U.S. 5,673,401) taken alone and/or in view of Discount et al. (U.S. 6,012,066) and/or in view of Carlin (U.S. Pub. No. 2002/0093538). As the Examiner correctly states in the Office Action at page 3, Volk is silent on "advertising texture maps" and goes on to combine Discount and Carlin.[2] As noted above in the section entitled "Rejection under 35 U.S.C. §103(a) over Discount and Carlin", the Carlin reference simply does not suggest, teach or disclose the patentably distinct limitations of "an application including a plurality of 3D objects, wherein each of the plurality of objects has a default texture associated therewith of to replace at least part of the default texture associated therewith" and mapping "advertising texture maps ... so as to replace at least part of the default texture associated therewith." Accordingly, the present invention distinguishes over Volk taken alone and/or in view of Discount and/or in view of Carlin for at least this reason and the Examiner's rejection should be withdrawn.

CONCLUSION

The remaining cited references have been reviewed and are not believed to effect the patentability of the claims as amended.

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable

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[2] Applicants make no statement whether such combination is even proper.

equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

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